

REMARKS**I. English Equivalent for DE 200 05 461**

US 2003/0019864 A1 was cited as reference D on the "Notice of References Cited" provided with the Office Action dated September 5, 2003 in the above-identified U.S. Patent Application.

The specification and claims of US 2003/0019864 A1 are English translations of the specification and claims of DE 200 05 461, according to the applicants (with the exception of course of the paragraph numbering in the published U.S. patent application). This is easily checked, for example, by comparing the patent document numbers in the background section, the drawing reference numbers in the detailed description and the claim structure and numbering in DE 200 05 461 with the same features in US 2003/0019864 A1.

US 2003/0019864 A1 is based on PCT/EP 01/01678 as priority document, but this PCT document is based on German Patent Application 100 14 373.2, filed March 23, 2000 in Germany. However a German "Gebrauchsmuster" application (utility model) for the same invention was also filed on March 23, 2000. This "Gebrauchsmuster" application is DE 200 05 461 U1.

Thus US 2003/0019864 A1 provides an English translation of DE 200 05 461, which is useful in further prosecution.

II. Obviousness Rejection based on Krause, et al. & Rapp, et al

Amended claims 1 to 16 were rejected under 35 U.S.C. 103 (a) as obvious over DE 200 04 461, Krause, et al, (referred to hereinafter as "Krause"), in view of U.S. Patent 6,299,940 B1, Rapp, et al (referred to hereinafter as "Rapp").

Applicants' amended claim 1 claims a cooking unit with a glass-ceramic panel. The features of the claimed invention are the following (see amendment dated 12/5/2003):

- (1) the glass-ceramic panel is transparent and colorless;
- (2) a full surface decorative coating on the top side of the panel
- (3) a solid or plain colored IR permeable coating on the underside; and
- (4) a cooking surface divided into cooking zones with heating elements.

In the dependent claims various specific features including temperature resistance properties of the paints used to provide the coating and their chemical composition are claimed.

Summarizing, the advantages of the special combination of features 1 to 4 are first the glass-ceramic panel is not made from a very expensive colored glass melt, but instead from a colorless glass melt. The use of coatings on the top and bottom of the glass-ceramic panel provides great flexibility in selection of color impressions produced by the coatings, so that the conspicuousness of dirt or similar marks, such as fingerprints, on the top surface of the cooking panel is reduced. Furthermore the topside full surface decorative coating protects the glass-ceramic panel from scratches, metal abrasion and usage marks.

In contrast claim 1 of Krause requires a coating-free or decoration-free upper surface of the glass-ceramic panel (see the last two lines of claim 1 in US 2003/0019864 A1 and also the DE reference "dekorfrei"). In the panel of Krause the decorative coating is the coating on the underside of the glass ceramic panel.

The reason that Krause teaches that the glass-ceramic panel should be free of a coating or decoration on its upper surface is explained on page 4, lines 1 to 10, of the DE reference and in paragraph 11 on page 1 of US 2003/0019864 A1. By keeping the upper surface of the glass-ceramic or glass panel free of a decorative layer or coating the glass-ceramic or glass panel is easier to clean and smoother than it would be if it had a top surface decorative layer. Also the absence of a coating on the top surface of the panel makes the color impression provided by the decorative coating on the underside more brilliant (see paragraph 11). A coating on the topside of the panel would obscure the decorative coating on the underside.

Thus not only does Krause teach that the top surface of the glass-ceramic or glass panel should be free of a decorative coating but Krause explains several reasons why that helps to achieve the purposes and objects of his invention.

In contrast, claim 1 of the above-identified U.S. Patent application requires a decorative layer or coating on the upper surface of the glass-ceramic or glass panel and a solid or plain colored (thus without a decorative pattern) IR permeable coating on the underside. The purpose of the decorative coating on the top surface of the glass-ceramic or glass panel is also to make dirt and soiling less conspicuous and to provide some protection from scratches and

usage marks and the like for the upper surface of the panel (see lines 5 to 10 of page 4 of the above-identified U.S. Patent Application).

Thus Krause, et al, clearly teaches the exact opposite of the claimed invention of the above-identified U.S. Patent Application. Krause, et al, requires that the top surface of the panel is decoration-free in the main independent claim of that reference (true for all embodiments in Krause, et al), while the applicants require a decorative coating 7 on the top surface of the panel in all of their embodiments. There is no way to keep the top surface of the panel decoration-free and provide it with a decorative coating; these are exclusive alternatives.

Rapp does teach that a decorative coating should be applied to a surface of a glass-ceramic panel in order to prevent the viewing of the surface of the glass-ceramic panel in claim 1, as shown in figs. 1 to 3. Rapp also teaches *similar* paint compositions to those of Krause and the present invention.

However Rapp and Krause cannot be combined under 35 U.S.C. 103 (a) to reject applicants' claimed invention, as claimed in applicants' claim 1, if legal precedents established by U.S. judicial decisions are followed.

According to M.P.E.P. (Manual of Patent Examining Procedure) 2145. X. D. 2. (and the court decision cited therein) one reference that teaches away from a claimed combination cannot be combined with another reference under 35 U.S.C. 103 (a) to reject the claimed combination as obvious. Not only does Krause teach away from providing a decorative coating on the top surface of the cooking panel, but Krause teaches the opposite; Krause states that the top surface, for the purposes and objects of his invention, must be decoration free. In

Krause the decorative coating is provided on the underside, not the top side. Thus these two references cannot be combined under 35 U.S.C. 103 (a) to reject applicants' amended claim 1.

Furthermore the interpretation and construction of patent claims has been held to be a matter of law to be decided ultimately exclusively by the courts. **Markham v. Westview Instruments, Inc. aff'd. (en banc)**, 38 U.S.P.Q. 2nd 1461 (1996). U.S. judicial decisions generally hold that a prior art reference that teaches the opposite from a claimed invention cannot be combined with other prior art references to reject the claimed invention under 35 U.S.C. 103 (a). For example, the Federal Circuit Court of Appeals has said:

"That the inventor achieved the claimed invention by doing what those skilled in the art suggested should not be done is a fact strongly probative of nonobviousness." In **Kloster Speedsteel AB v. Crucible Inc.**, 230 U.S.P.Q. 81 (Fed. Cir. 1986), on rehearing, 231 U.S.P.Q. 160 (Fed. Cir. 1986).

Thus Krause, which teaches that the upper surface of a glass ceramic or glass panel should be decoration-free, cannot be applied under 35 U.S.C. 103 (a), or combined with Rapp, to reject a claimed glass-ceramic or glass panel with a decorative coating on its top surface, as claimed in applicants' claim 1.

In addition, the primary reference (Krause) cannot be combined with a second reference (Rapp) under 35 U.S.C. 103 (a) to reject the claimed combination (claim 1) if the proposed modification would render the invention of the primary reference unsatisfactory for its intended purpose. See M.P.E.P. 2143.01. The proposed modification here is to provide a decorative coating on

the otherwise undecorated top surface of the glass-ceramic panel of Krause. This would make the claimed glass-ceramic panel of Krause unsatisfactory for its intended purpose, as stated on page 4, lines 1 to 10, of the DE reference and in paragraph 11 on page 1 of US 2003/0019864 A1. One purpose of keeping the upper surface of the glass-ceramic or glass panel free of a decorative layer or coating, as noted above, is to make the decorative coating applied to the underside of the panel of Krause more brilliant. An additional topside coating would obscure the decorative coating provided on the underside of the panel in the case of Krause.

Furthermore, the invention claimed by Rapp is a method of making a glass-ceramic panel with a "completely closed" full surface decorative coating on a surface of the glass ceramic panel according to claim 1 of Rapp. But Rapp does not teach or suggest that the method should be applied to provide a decorative coating that completely covers the entire cooking surface or the entire top surface of a glass ceramic panel, instead of the bottom surface. In fact, the glass ceramic article claimed in claims 1 to 4 of Rapp does not need to be a glass ceramic panel that provides a cooking surface or an article used in a cooking range or unit.

Also Rapp does not suggest that the decorative coating should be a full surface coating in the sense of the present invention, which covers the entire top surface of the glass ceramic panel including the cooking zones (see applicants' figure accompanying the specification; page 15, lines 20 to 22, of applicants' specification). If the decorative coating did not cover the cooking zones as

claimed in applicants' claim 1, it could not prevent the top surface from being scratched by pots and pans resting on the cooking surface (see the second paragraph on page 5 of the applicants' disclosure). In fact, in column 4, lines 61 to 67, Rapp teaches that the decorative coating is best omitted from the cooking or heat maintaining zones for the purpose of improving heat transfer.

It is well established by many U. S. Court decisions that to reject a claimed invention under 35 U.S.C. 103 there must be some hint or suggestion in the prior art of the modifications of the disclosure in a prior art reference or references used to reject the claimed invention, which are necessary to arrive at the claimed invention. For example, the Court of Appeals for the Federal Circuit has said:

"Rather, to establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant...Even when obviousness is based on as single reference there must be a showing of a suggestion of motivation to modify the teachings of that reference.." *In re Kotzab*, 55 U.S.P.Q. 2nd 1313 (Fed. Cir. 2000). See also M.P.E.P. 2141

Rapp does not teach or suggest the limitation that the decorative coating is a full surface coating, which completely covers the top surface of the glass ceramic panel that provides the cooking surface including the cooking zones. In fact, Rapp contains teaching in column 4 that states that it is better to omit the decorative coating from the cooking zones to improve heat transfer. Rapp teaches that it is better to use a grate for support of the cooking pans at this point in the disclosure and thus teaches away from the invention claimed in applicants'

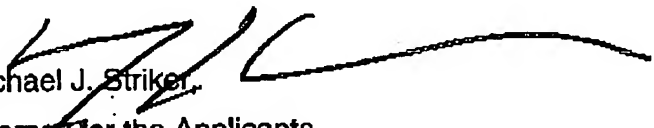
amended claim 1.

For the foregoing reasons withdrawal of the rejection of amended claims 1 to 16 under 35 U.S.C. 103 (a) over DE 200 04 461, Krause, et al, in view of U.S. Patent 6,299,940, Rapp, et al, is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects to put this case in condition for final allowance, then it is requested that such amendments or corrections be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing the case to allowance, he or she is invited to telephone the undersigned at 1-631-549 4700.

In view of the foregoing, favorable allowance is respectfully solicited.

Respectfully submitted,



Michael J. Striker
Attorney for the Applicants
Reg. No. 27,233